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09/558,313	04/25/2000	Amit D. Agarwal	23984-13939 US	9641
758 7590 12/09/2008 FENWICK & WEST LLP SILICON VALLEY CENTER 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041			EXAMINER BUCHANAN, CHRISTOPHER R	
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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/558,313
Filing Date: April 25, 2000
Appellant(s): AGARWAL, AMIT D.

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 1, 2006 appealing from the Office action mailed December 29, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is partially correct; however this Examiner's Answer includes the following **new grounds of rejection.**

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-14, 27-30, and 39-44 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, claims 1-14, 27-30, and 39-44 are non-statutory.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. *Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.*

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Claims 36-37 are rejected under 35 USC 101 as being directed to a data structure which does not fall within one of the four categories of invention and is therefore non-statutory.

Claim 38 is rejected under 35 USC 101 as being directed to a signal which does not fall within one of the four categories of invention and is therefore non-statutory.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,026,376	KENNEY	2-2000
5,909,023	ONO et al.	6-1999
5,655,174	HIRST	8-1997

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-14, 27-30, and 39-44, are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In *re* Bilski et al, 88 USPQ 2d 1385 CAFC (2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, claims 1-14, 27-30, and 39-44 are non-statutory.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. *Note the Board*

of Patent Appeals Informative Opinion Ex parte Langemyer et al.

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Claims 36-37 are rejected under 35 USC 101 as being directed to a data structure which does not fall within one of the four categories of invention and is therefore non-statutory.

Claim 38 is rejected under 35 USC 101 as being directed to a signal which does not fall within one of the four categories of invention and is therefore non-statutory.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-26 and 36-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenney (US 6,026,376) in view of Ono (US 5,909,023).

Kenney discloses a method in a data processing system for automatically initiating the replenishment of a consumable product that includes the steps of receiving an order for a customer and filling that order on a first date (col. 4 line 25+) and estimating a target date for suggesting replenishment (col. 11 lines 12-34, order frequency and average time amount to determining a "target date"). The user is provided with an indication that the product should be replenished (see Figs 5 and 7, col. 12 line 50+, it is displayed which products need to be reordered). The consumer then requests replenishment of the product by performing an interaction (clicking on the displayed product, col. 12 line 56) and the product is ordered (see Fig. 10A). The target date is estimated based on the first date and the average life span of the item, which in turn is determined by the length of intervals between purchases (col. 11 lines 26-34). It is implicit that Kenney employs a computer memory and a computer-readable medium containing instructions for carrying out the method.

Kenney does not disclose transmitting information of a good whose purchase interval has lapsed or providing an indication to the consumer on or before the target date.

Ono discloses a purchase history information of each good purchased by a user that is stored at a service offering system (abstract, Fig. 5) and in response to an input of identification information from a service use system, the service offering system searches the purchase history information of the user corresponding to a user identifier and calculates a purchase interval of each good purchase by a user (102, Fig. 1), the service offering system judges, for each good whose purchase interval was calculated,

whether the time corresponding to the purchase interval has lapsed after the latest purchase day (103, Fig. 1) and the service offering system transmits information of the good whose time corresponding to the purchase interval has lapsed to the service via a communication network and displaying the information at the service use system (abstract, 104, 223, Fig. 1).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Kenney to transmit information of the good whose purchase interval has lapsed or to provide an indication to the consumer on or before the target date, as taught by Ono, so the consumer will not run out of the item because it would estimate a demand occurrence time for each good and supply a user with the merchandise information at the estimated time of the next purchase.

Furthermore, the items being sold in Kenney are physical articles. However, the type of item being sold does not alter how the system functions, so this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the system of Kenney to sell any type of item because the type of item does not patentably distinguish the claimed invention.

Neither Kenney nor Ono teaches the step of determining a target date based on availability of an item. However, it is common in the art to only suggest the purchase of an item if that item is in stock. It therefore would have been obvious to one of ordinary

skill in the art at the time the invention was made to use the availability of the item to determine a target date so that the indication is sent only if the item is available.

Neither Kenney nor Ono teaches the step of determining a target date based on the size of the item. However, it is commonly known in the art that the size of an item will impact the length of time it takes to consume. It would have been obvious to one of ordinary skill in the art at the time the invention was made to determine a target date based on the size of the item, so that a more accurate date is determined.

Neither Kenney nor Ono teaches the step of determining a target date base on an expiration date. However, it is commonly known in the art that items need to be replaced after they expire. It would have been obvious to one of ordinary skill in the ad at the time the invention was made to employ to determine a target date based on an expiration date so that a customer will replace expired items.

Claims 27-35 and 45-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenney (US 6,026,376) in view of Ono (US 5,909,023) and further in view of Hirst (US 5,655,174).

Kenney and Ono teach all of the limitations of the claims except for the step of scheduling a time for transmission of a unilateral transmission indicating that the item should be purchased.

Hirst discloses a processor (38) providing a signal to controls and displays (42) to indicate a warning message reminder (128, 130, Fig. 6) to schedule a reordering

process for a particular product and sometimes the reordering is done automatically as claimed.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the message indication and the automating reordering, as taught by Hirst, in the combined system of Kenney in view of Ono because it would ensure that customers are aware of an upcoming event and that products are ordered in a timely fashion.

(10) Response to Argument

Appellant argues that a *prima facie* case has not been presented for the rejection of claims 39-44 because the rejection does not specifically address the limitations recited in these claims. The examiner has reviewed the last rejection (mailed 12/29/2005) and notes that claims 39, 40, 41, and 44 are not specifically mentioned in the rejection. However, the examiner contends that this is merely an oversight in numbering and the limitations recited in the claims have been addressed in the rejection. The numbering of claims being addressed has been modified in the rejection above to correct this issue.

Appellant argues that the prior art references used in the rejection above do not disclose all the claimed features of the instant invention and that there is no motivation to combine the teachings of the different references. In particular, appellant argues that Kenney fails to disclose a control that may be used to request replenishment of a product by performing a single action or a defined region in which a user may perform a

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single mouse click to request replenishment of the product. Appellant also argues that Kenney fails to disclose placing an order on the consumer's behalf for replenishment of the item within a predetermined tolerance of the target date. Appellant further argues that Ono fails to disclose providing information regarding a good whose purchase interval has lapsed or determining a target date for suggesting replenishment of an item. Appellant further argues that the references fail to disclose scheduling for a time preceding the expiration time a unilateral transmission to the purchasing entity that the item should be purchased.

The examiner disagrees and stands by the rejection. Kenney discloses that a shopper can select a product to be ordered by clicking on the product while it is displayed on the computer screen (col. 12 line 55+). The examiner interprets this as performing a single action and the location on the screen for displaying products to be a defined region for making requests (see Figs. 5-9). Kenney also discloses that a product reorder list is made by considering order frequency and average time between product purchases (col. 11 line 21+) and that the reorder list can be automatically generated (col. 11 line 30). The examiner interprets this as determining a target date and placing orders on the consumer's behalf within the target date. Ono discloses determining whether a product purchase interval has lapsed after the latest purchase day (103, Fig. 1) and transmitting information of a good whose purchase interval has lapsed to a service offering system and displaying the information at the service use system (abstract, 104, 223, Fig. 1). The examiner interprets this as providing information regarding a good whose purchase interval has lapsed and determining a

target date for suggesting replenishment of an item. Hirst discloses providing a signal to controls and displays to indicate a warning message reminder (128, 130, Fig. 6) to schedule a reordering process for a particular product. The examiner interprets this as scheduling for a time preceding the expiration time a unilateral transmission to the purchasing entity that the item should be purchased. Lastly, motivation for combining the references has been provided in the rejection above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

Respectfully submitted,

/Christopher Buchanan/

Christopher Buchanan

Conferees:

/F. Ryan Zeender/

Supervisory Patent Examiner, Art Unit 3627

Art Unit: 3627

Vincent Millin

Vincent Millin
Appeals Practice
Specialist

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

Wynn Coggins

WYNN W. COGGINS
TECHNOLOGY CENTER DIRECTOR

Wynn Coggins